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10/508,807	09/24/2004	Harald Schiller	PD020018	3910

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Joseph S Tripoli  
Thomson Multimedia Licensing Inc  
Patent Operations CN 5312  
Princeton, NJ 08543-0028

EXAMINER

MORRISON, JAY A

ART UNIT PAPER NUMBER

2168

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/508,807

Applicant(s)

SCHILLER ET AL.

Examiner

Jay A. Morrison

Art Unit

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/24/04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Claims 1-9 are pending.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1,5 and 7-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: "accessing said multimedia essence". The Applicant discloses the other steps as claimed in the preamble, but not the final step of the preamble, "accessing the multimedia essence".

Claim 1 recites the limitation "the content" in line 6. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination the Office will assume the Applicant meant "content".

Claim 5 recites the limitation "the mapping" in line 6. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination the Office will assume the Applicant meant "mapping".

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: "accessing said multimedia essence". The Applicant discloses the other steps as claimed in the preamble, but not the final step of the preamble, "accessing the multimedia essence".

Claim 7 recites the limitation "said transformation" in line 3. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination the Office will assume the Applicant meant "said transformation rules".

Claim 8 recites the limitation "the content" in line 3. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination the Office will assume the Applicant meant "content".

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1 and 4-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims do not recite a practical application by producing a physical transformation or producing a useful, concrete, and tangible result. To perform a physical transformation, the claimed invention must transform an article or physical object into a different state or thing. Transformation of data is not a physical transformation. A useful, concrete, and tangible result must be

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either specifically recited in the claim or flow inherently therefrom. To be useful the claimed invention must establish a specific, substantial, and credible utility. To be concrete the claimed invention must be able to produce the same results given the same initial starting conditions. To be tangible the claimed invention must produce a practical application or real world result. In this case the claims fail to perform a physical transformation because the claims are directed to operating on data. The claims are useful and concrete, but they fail to product a tangible result because they fail to produce a concrete result such as storing the method onto a computer readable medium, displaying the results to a user, for example.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3,5-6,8-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Srivastava et al. ('Srivastava' hereinafter) (Patent Number 6,549,922).

As per claim 1, Srivastava teaches

Method for using metadata from different sources, said metadata describing and being linked to multimedia essence and being used for accessing said multimedia essence, comprising (see abstract and background)

receiving original metadata from different sources; (multiple paths, column 2, lines 45-50)

deriving from said original metadata unified metadata using one or more transformation rules, said transformation rules specifying how the content or parts of the content of said original metadata shall be used to constitute the content or part of the content of said unified metadata. (column 2, lines 40-65).

As per claim 2, Srivastava teaches

presenting said derived unified metadata to a user; processing said derived unified metadata in response to a user input. (client interface, column 3, line 13 through column 4, line 30)

As per claim 3, Srivastava teaches

said processing results in selecting, deleting or modifying said unified metadata. (client interface, column 3, line 13 through column 4, line 30)

As per claim 5, Srivastava teaches

said original metadata contain links, and where a part of said transformation rules covers the mapping or inheritance of said links from within said original metadata into all derived said unified metadata. (URL, column 3, line 63 through column 4, line 7)

As per claim 6, Srivastava teaches

said original metadata are at least partly structured and where said transformation rules are at least partly based on examining and evaluating the structure of said original metadata. (according to type of media file, column 4, lines 32-48)

As per claims 8-9,

These claims are rejected on grounds corresponding to the arguments given above for rejected claims 1-2 and are similarly rejected.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Srivastava et al. ('Srivastava' hereinafter) (Patent Number 6,549,922) as applied to claim 1 above, and further in view of Muhlestein (Patent Number 6,279,011).

As per claim 4,

Srivastava does not explicitly indicate "storing the original metadata; keeping the stored original metadata unchanged; and enabling to recur from the unified metadata to the original metadata."

However, Muhlestein discloses "storing the original metadata; keeping the stored original metadata unchanged; and enabling to recur from the unified metadata to the original metadata" (column 1, lines 49-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Srivastava and Muhlestein because using the steps of "storing the original metadata; keeping the stored original metadata unchanged; and enabling to recur from the unified metadata to the original metadata" would have given those skilled in the art the tools to improve the invention by having the ability to restore



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data to its original state. This gives the user the advantage of have a backup so that data is not lost.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Srivastava et al. ('Srivastava' hereinafter) (Patent Number 6,549,922) as applied to claim 1 above, and further in view of Light (Patent Number 6,389,412).

As per claim 7,

Srivastava does not explicitly indicate "said original metadata at least partly consist of sequences of words not otherwise structure, where said transformation at least partly involves a search phrase, where said transformation rules are at least partly based on evaluating a phrase similarity measure, where said phrase similarity measure is based on word order and/or word distance measures, and where, prior to applying said phrase similarity measure, the words of said original metadata and of said search phrase are optionally normalized by applying a stemming algorithm."

However, Light discloses "said original metadata at least partly consist of sequences of words not otherwise structure, where said transformation at least partly involves a search phrase, where said transformation rules are at least partly based on evaluating a phrase similarity measure, where said phrase similarity measure is based on word order and/or word distance measures, and where, prior to applying said phrase similarity measure, the words of said original metadata and of said search phrase are optionally normalized by applying a stemming algorithm" (column 4, lines 35-58).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Srivastava and Light because using the steps of "said original metadata at least partly consist of sequences of words not otherwise structure, where said transformation at least partly involves a search phrase, where said transformation rules are at least partly based on evaluating a phrase similarity measure, where said phrase similarity measure is based on word order and/or word distance measures, and where, prior to applying said phrase similarity measure, the words of said original metadata and of said search phrase are optionally normalized by applying a stemming algorithm" would have given those skilled in the art the tools to improve the invention by creating metadata allowing for searching based on phrases which include information normally eliminated by stemming. This gives the user the advantage of having a better search tool.

### ***Conclusion***

The prior art made of record, listed on form PTO-892, and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay A. Morrison whose telephone number is (571) 272-7112. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on (571) 272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jay Morrison  
TC2100

A handwritten signature in black ink, appearing to read 'Debbie Le', written over a horizontal line.

Debbie Le  
TC2100

7/6/06